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EXAMINER

KOHUT, DAVID M

ART UNIT PAPER NUMBER

3691

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/025,036

Applicant(s)

CAMPBELL, BRUCE M.

Examiner

David M. Kohut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12 February 2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(e) to Provisional Application Serial No. 60/256,770. The effective filing date for this application is 12/19/2000.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "26a" and "26b". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure is objected to because of the following:
- a. Page 15, line 3, remove "as an customer" or replace "an" with "a";
 - b. Page 15, line 4, remove the "s" from "peoples";
 - c. Page 15, line 9, insert "as" after such.

Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities:
- d. Page 2, line 12, change "visual" to "video";
 - e. Page 3, line 3, change "otherwise" to "etc." or something similar;
 - f. As per the entire specification, Applicant makes reference to the following reference numerals that are not shown in the drawings: "10", "12", "14", and "16".
Applicant is requested to amend the drawings to show these reference characters or remove reference character numerals;
 - g. Page 5, line 14, change "to submit" to "submits";
 - h. Page 6, line 22, "required" is misspelled;
 - i. Page 8, line 18, insert "and" between "color" and "high";
 - j. Page 10, line 1, change "effect" to "affect".

Appropriate correction is required.

Claim Objections

5. Claim 1 is objected to because of the following informalities: after "...wherein the at least one image..." there should be an "is" so that the sentence reads, "...wherein the at least one image is designated..." Appropriate correction is required.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

k. Claim 1, line 9, contains the phrase "...into the stock book;..." Examiner interprets this phrase to mean "...into a stock book;..." since "stock book" was not mentioned previously. Applicant is requested to make the appropriate change.

l. Claim 4, line 14, contains the phrase "...selected from the group..." Examiner interprets this phrase to mean "...selected from a group..." since "group" was not mentioned previously. Applicant is requested to make the appropriate change.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 7-14 are rejected under 35 U.S.C. 101.

9. Claim 7 is directed to a method for the production of a customized product wherein the custom information is integrated into the desired product. Claim 7 does not provide a practical application that produces a useful result. For an invention to be

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"useful" it must satisfy the utility requirement of section 101. The USPTO's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP § 2107. Claim 7 merely results in integrating the information into a product, and does not utilize said integrating to manifest a useful result, i.e. manufacturing the customized product.

10. Claims 8-14 do not cure the deficiencies set forth in claim 7, and as such are rejected for the same reasons.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 3-4, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada, Japanese Patent No. JP 11128553A, reference N on the attached PTO-892.

13. As per claim 1, Yamada teaches the method of producing a customized book, the method comprising: providing a book wherein the book has text blanks for insertion therein of customized text and image blanks for insertion therein of customized images, i.e. every page of an illustrated book is previously provided with blanks and the characters the characters and names of the illustrated book are freely determined (see lines 5-6 and 17 of Yamada); receiving text from a customer, wherein the text is designated for insertion into the book at the text blanks, i.e. the characters and names

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of the (personal) illustrated book are freely determined (wherein the customer must provide the characters and names in order for the book to be personal)(see lines 13 and 16-17 of Yamada); receiving an at least one image from a customer, wherein the at least one image from a customer, wherein the at least one image is designated for insertion into the book at the image blanks, i.e. pictures of the characters taken by a digital camera are processed by a computer, laid out into the blank of the characters, and printed to complete the illustrated book (see lines 10-12 of Yamada); integrating the received text and images into the stock book, i.e. pictures of the characters are laid out into the blank of characters and the names are freely determined (see lines 8-11 and 17 of Yamada); and printing the customized book, i.e. the illustrated book is printed (see lines 11-12 of Yamada).

14. As per claim 3, Yamada teaches the method of claim 1 as described above. Yamada further teaches a method wherein the text further comprises names, i.e. characters and names of the illustrated book are freely determined (see line 17 of Yamada).

15. As per claim 4, Yamada teaches the method of claim 1 as described above. Yamada further teaches a method wherein the at least one image is selected from a group consisting of photographs, drawings, computer images and stock images, i.e. pictures of the characters taken by a digital camera are processed by a computer, laid out into the blank of the characters, and printed to complete the illustrated book (see lines 8-12 of Yamada).

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16. As per claim 15, Yamada teaches the method for customizing a book, the method comprising: querying a customer for a set of custom information, i.e. characters and names of the illustrated book are freely determined (see line 17 of Yamada); receiving from the customer the set of custom information, i.e. pictures of the characters are laid out into the blank of the characters (see lines 8-11 of Yamada); querying the customer for at least one image for inclusion in the customized book, i.e. every page of an illustrated book is previously provided with blanks of specified characters in a story of the illustrated book which will allow for the book to be personalized (see lines 5-7 and 13 of Yamada); receiving from the customer at least one image, i.e. pictures of the characters are laid out into the blank of the characters (where the customer must provide the pictures in order for the book to be personalized)(see lines 8-11 and 13 of Yamada); integrating the set of custom information and the at least one image into a layout for the customized book, i.e. pictures of the characters are laid out into the blank of characters and the names are freely determined (see lines 8-11 and 17 of Yamada); and printing the customized book, i.e. the illustrated book is printed (see lines 11-12 of Yamada).

17. Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosewarne et al., U.S. Patent No. 4,616,327, reference A on the attached PTO-892.

18. As per claim 7, Rosewarne et al. teaches the method for the production of a customized product, the method comprising: providing a customer with a list of customizable products, i.e. it is possible, employing a microprocessor based computer system, to develop a system capable of not only text personalization, but graphic

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personalization, as well, in producing books, posters, greeting cards and the like (see column 2, lines 32-36 of Rosewarne et al.); receiving from the customer a selection of a product for customization, i.e. a portion of a large poster will be plotted (see column 5, lines 41-43 of Rosewarne et al.); querying the customer for a set of custom information in response to the customer's selection of the customizable product, i.e. a number of personalized data are entered in the card by blacking out the appropriate choice, the first choice being three age categories; the second category for gender allows, of course two selections, and a number of the selections and the general tone of the examples are humorous (see column 3, lines 60-63 and 67-68 and column 4, line 1 of Rosewarne et al.); receiving from the customer the set of custom information, i.e. the optical reader scans the card containing the personalized data and is stored in memory (see column 4, lines 12-14 and 22 of Rosewarne et al.); integrating the set of custom information into the desired product, i.e. when completed, the document, which may be a poster, card, booklet or the like, includes the standardized text, the personalized text, the background graphics, and the foreground, personalized graphics or pictorial display (see column 4, lines 67-68 and column 5, lines 1-4 of Rosewarne et al.).

19. As per claim 8, Rosewarne et al. teaches the method of claim 7 as described above. Rosewarne et al. further teaches the method wherein the customized product is selected from the group consisting of a book, a toy, a game, and a business product, i.e. it is possible, employing a microprocessor based computer system, to develop a system capable of not only text personalization, but graphic personalization, as well, in

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producing books, posters, greeting cards and the like (see column 2, lines 32-36 of Rosewarne et al.).

20. As per claim 9, Rosewarne et al. teaches the method of claim 7 as described above. Rosewarne et al. further teaches the method wherein the set of custom information includes text, i.e. a portion of a larger poster will be plotted with the name, SEAN (see column 5, lines 41-43 of Rosewarne et al.).

21. As per claim 10, Rosewarne et al. teaches the method of claim 7 as described above. Rosewarne et al. further teaches the method wherein the set of custom information includes names, i.e. a portion of a larger poster will be plotted with the name, SEAN (see column 5, lines 41-43 of Rosewarne et al.).

22. As per claim 11, Rosewarne et al. teaches the method of claim 7 as described above. Rosewarne et al. further teaches the method wherein the set of custom information includes images, i.e. when completed, the document, which may be a poster, card, or booklet or the like includes...personalized graphics or pictorial display (see column 4, lines 67-68 and column 5, lines 4-5 of Rosewarne et al.).

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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24. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada, Japanese Patent No. JP411128553A, reference N on the attached PTO-892, in view of Martin et al., U.S. Patent No. 5,764,276, reference C on the attached PTO-892.

25. As per claim 2, Yamada teaches the method of claim 1 as described above.

However, Yamada does not explicitly teach downloading text and images from a Website. Martin et al, however, does explicitly teach the method wherein receiving the text and images further comprises downloading the text and images from a Website, i.e. the different ways of downloading image data files and command sequencing data files include satellite downloading, modem downloading (including from bulletin boards and the Internet) and broadcast downloading (see column 5, line 67 and column 6, lines 1-4 of Martin et al.). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method of Yamada. One of ordinary skill in the art would have been motivated to incorporate this feature so that the files do not have to be loaded directly to a user's computer but rather onto a central server which allows access through a variety of communication networks (see column 6, lines 8-11 of Martin et al.).

26. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada, Japanese Patent No. JP411128553A, reference N on the attached PTO-892, in view of Martin et al., U.S. Patent No. 5,764,276, reference C on the attached PTO-892, as applied to claim 2 above, and further in view of Squilla et al., U.S. Patent No. 6,123,362, reference B on the attached PTO-892.

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27. As per claim 5, Yamada and Martin et al. teach the method of claim 2 as described above. However, neither Yamada nor Martin et al. explicitly teach the method of allowing the customer to select the location of the image. Squilla et al., however, does explicitly teach the method comprising allowing the customer to select the location and placement of the at least one image in the book, i.e. the page layouts that are available for each of the page layout form allow the user to select the desired placement of the images in each page (see column 7, lines 53-56 of Squilla et al.). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method of Yamada and Martin et al. One of ordinary skill in the art would have been motivated to incorporate this feature so the exact layout can be selected by the customer (see column 2, line 52 of Squilla et al.).

28. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada, Japanese Patent No. JP411128553A, reference N on the attached PTO-892, in view of Johnson et al., U.S. Patent No. 5,063,698, reference D on the attached PTO-892.

29. As per claim 6, Yamada teaches the method of claim 1 as described above. However, Yamada does not explicitly teach the method of receiving sounds and inserting them into the book. Johnson et al., however, does teach a method comprising receiving recorded sounds from the customer, i.e. recording the message given via telephone from the remote location to the centralized location (where the message is personalized for the recipient)(see column 1, lines 7-8 and column 4, lines 40-41 of Johnson et al.); and inserting the recorded sounds into the customized book, i.e. providing a personalized greeting card wherein the personalized message is recorded

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as electronic signals in an electronic memory device (see column 1, lines 44-47 of Johnson et al.). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method of Yamada. One of ordinary skill in the art would have been motivated to incorporate this feature in order to advance personalization by delivering an audio message that is electronically embodied in circuitry (see column 1, lines 10-13 of Johnson et al.).

30. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosewarne et al., U.S. Patent No. 4,616,327, reference A on the attached PTO-892, in view of Johnson et al., U.S. Patent No. 5,063,698, reference D on the attached PTO-892.

31. As per claim 12, Rosewarne et al. teaches the method of claim 7 as described above. However, Rosewarne et al. does not explicitly teach the method of including sound. Johnson et al., however, does explicitly teach the method wherein the set of custom information includes sounds, i.e. the present invention relates to a greeting card with an electronic sound recording that embodies a personalized message for the recipient (see column 1, lines 6-8 of Johnson et al.). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method of Rosewarne et al. One of ordinary skill in the art would have been motivated to incorporate this feature in order to advance personalization by delivering an audio message that is electronically embodied in circuitry (see column 1, lines 10-13 of Johnson et al.).

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32. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosewarne et al., U.S. Patent No. 4,616,327, reference A on the attached PTO-892, in view of the PromoMart website from April 16, 1997, reference U on the attached PTO-892, and Vulkan, Nir, *Economic Implications of Agent Technology and E-Commerce*, Royal Economic Society, February 1999, Blackwell Publishers, Volume 109, pages F67-F90, reference V on the attached PTO-892.

33. As per claim 13, Rosewarne et al. teaches the method of claim 7 as described above. However, Rosewarne et al. does not explicitly teach the method of providing a website. Promomart's website printout, however, does explicitly teach the method wherein providing the customer with a list of customizable products further comprises providing a downloadable Web page accessible through the Internet, i.e. after observing the Promomart website from the 16th of April 1997, through the use of the WayBack Machine, and clicking on the "search for promotional products" link, it lists a number of promotional items that can be customized (see www.promomart.com from 1997, pages 1-8, reference U on the attached PTO-892). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method of Rosewarne et al. One of ordinary skill in the art would have been motivated to incorporate this feature because the Internet offers 24 hour a day access to a large number of potential customers from all over the world with relatively low overheads (see page F67, lines 16-18 of *The Economic Journal*).

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34. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosewarne et al., U.S. Patent No. 4,616,327, in view of Yamada, Japanese Patent No. JP411128553A.

35. As per claim 14, Rosewarne et al. teaches the method of claim 7 as described above. However, Rosewarne et al. does not explicitly teach the method of inserting images and text into blanks. Yamada, however, does explicitly teach the method of querying the customer for a set of custom information further comprising providing a custom product with image blanks and text blanks, i.e. every page of an illustrated book is previously provided with blanks of specified characters in a story of the illustrated book so that the characters and names of the illustrated book are freely determined (see lines 5-7 and 17 of Yamada). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method of Rosewarne et al. One of ordinary skill in the art would have been motivated to incorporate this feature in order to create a personal book that is different from any other and can be made at a low cost in a manner that characters and names of the illustrated book are freely determined (see Yamada, lines 13-17).

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Conclusion

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Kohut, Esq. whose telephone number is 571-270-1369. The examiner can normally be reached on M-Th 730-5 w/1st Fri off. 2nd Fri 730-4.

2. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

3. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DMK
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11/8/06